

REMARKS

Applicants thank the Examiner for the consideration given the present application. Claims 55-79 are pending. Claims 55-79 are new. Claims 1-15 have been cancelled herein and Claims 16-54 were cancelled previously.

Specifically, support for Claim 55 is found at page 1, lines 33-34, page 10, lines 12-20 and page 14, lines 17-28.

Support for Claim 56 is found in Example 8.

Support for Claim 57 is found at page 13, line 17 and in Example 10.

Support for Claim 58 is found in Example 6 and at page 12, line 29.

Support for Claim 59 is found in Claims 1 and 4 as originally filed.

Support for Claim 60 is found in Example 6 and at page 12 line 29.

Support for Claim 61 is found at page 14, lines 24-28.

Support for Claim 62 is found at page 14, lines 24-28.

Support for Claim 63 is found at page 14, lines 24-28.

Support for Claim 64 is found at page 14, lines 24-28.

Support for Claim 65 is found in Claim 9 and 13 as originally filed.

Support for Claim 66 is found in Claims 12 and 15 as originally filed.

Support for Claim 67 is found in Examples 2 and 3.

Support for Claim 68 is found at page 11, lines 34-36.

Support for Claim 69 is found in Examples 4 and 6.

Support for Claim 70 is found in Examples 5 and 9.

Support for Claim 71 is found in Examples 4 and 8.

Support for Claim 72 is found in Examples 4 and 10.

Support for Claim 73 is found at page 13, line 23.

Support for Claim 74 is found at page 13, line 24.

Support for Claim 75 is found at page 10, line 22.

Support for Claim 76 is found at page 10, line 21.

Support for Claim 77 is found in Examples 10 and 8.

Support for Claim 78 is found at page 10, lines 27-36 and Example 10.

Support for Claim 79 is found at page 10, lines 29-30 and throughout the Examples.

The Rejection under 35 U.S.C. § 101

Claims 5, 6 and 9-15 stand rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter because the claims are drawn to both an apparatus and a method of using the apparatus. In a sincere effort to advance prosecution of this case, Claims 5, 6 and 9-15 have been cancelled herein. Additionally, Applicants respectfully assert that as presented herein, the new claims are all directed to a process and thus, are not subject to this rejection. Therefore, Applicants respectfully request the rejections under §101 be withdrawn.

The Rejection under 35 U.S.C. § 112, second paragraph

Second Paragraph of §112

Claims 5, 6 and 9-15 have been rejected under 35 U.S.C. § 112, second paragraph for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Specifically, the Examiner indicates that the claims are directed to both an apparatus and method of using the apparatus. As stated above, Claims 5, 6 and 9-15 have been cancelled herein and new Claims 55-79 are all process-related claims that avoid the issue stated by the Examiner. Therefore, Applicants respectfully request the rejection under §112 be withdrawn.

Synopsis of the Invention

The present invention is directed to processes to provide consumers quantities of ready-to-drink beverages, especially brewed coffee and coffee drinks (lattes, cappuccinos, etc.). The consumer may select a beverage, and various characteristics thereof, based upon his/her taste preferences.

More particularly, the present invention is directed to a process for making a brewed beverage comprising brewing a coffee extract in a brewer, storing the coffee extract in the brewer in contact with coffee grounds for from about 5 minutes to about 48 hours after onset of brewing the extract, and preparing the coffee beverage by successively filtering and dispensing at least a portion of the coffee extract stored in the brewer.

By following this process, and variations thereof, the present inventors have surprisingly discovered that the taste of the coffee beverage is improved. It is believed that storing the extract in contact with the coffee grounds allows the grounds to absorb reaction compounds, and buffer acids, generated during storage of the extract thereby providing a fresher, better tasting coffee beverage.

The Rejection under 35 U.S.C. §102

The Examiner has rejected Claim 1 under 35 U.S.C. § 102 as being anticipated by Adler, U.S. Patent No. 2,949,993. Specifically, the Examiner alleges that Adler discloses “a method which provides a choice of drinks to be chosen by the consumer, including coffee, coffee with cream, coffee with sugar, etc. by using a vending machine.” The Examiner continues by stating that “the vending machine of Adler is disclosed to hold coffee in the form of a concentrate wherein said concentrate is diluted with hot water when a coin is inserted in the machine and a choice of beverage is made.” Moreover, the Examiner states that “Adler’s invention is concerned with preserving the liquid coffee and other ingredients of the vending machine by using vacuum storage and wherein ‘materials may be kept in the machine over extended periods of time’.” Additionally, the Examiner notes that “although not specifying a particular time, it is considered inherent that ‘extended period of time’ would be well beyond a 5 minute interval of storage and that the apparatus of Adler would be able to perform in such a manner.” Finally, the Examiner states that Adler inherently provides a method of controlling dilution as the user of the apparatus is able to adjust the amount of water or other ingredients added such that said apparatus provides the desired amounts and combinations envisioned.” Applicants respectfully traverse this rejection.

Under 35 U.S.C. § 102, a claim is anticipated only if each and every claim element is found, either expressly or inherently disclosed, in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there. See *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). Additionally, there must be no difference between what is claimed and what is disclosed in the applied reference. See *Scripps v. Genetech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Moreover, it is incumbent on the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. *Ex parte Levy*, 17 USPQ2d 1461, 1462 (BPAI 1990).

As with the previous rejections, Applicants respectfully assert that Claim 1 has been cancelled herein in lieu of the presently added Claims 55-79. For this reason alone, Applicants respectfully request the Examiner withdraw the rejection under § 102.

However, in a sincere effort to advance the prosecution of the case, Applicants wish to address the Examiner’s rejections over Adler as they apply to the newly added claims. Applicants respectfully assert that Adler does not anticipate the present invention under §102 because Adler

does not teach a process for brewing coffee beverage that involves storing the coffee extract in contact with the grounds before filtering. Indeed, Adler is not even concerned with brewing coffee or coffee extracts in the first instance. Rather, the Adler machine simply dispenses pre-made liquid concentrates. Thus, as the Adler machine does nothing to control the brewing process or improve the beverage dispensed therefrom, Applicants respectfully assert that Adler does not anticipate the present invention under §102.

Moreover, Adler does not even suggest the use of delayed filtration. As aforementioned, the concentrates of Adler are pre-made and pre-packed, and thus, the Adler machine is not involved in the brewing process. For this additional reason, Applicants respectfully assert that Adler does not anticipate the present invention.

Therefore, for these reasons, it is respectfully requested that the Examiner withdraw the rejection under 35 U.S.C. §102.

The Rejection under 35 U.S.C. § 103

The Examiner has rejected Claim 1, as well as Claims 5, 6 and 9-15 under 35 U.S.C. § 103 as being unpatentable over Adler. Specifically, the Examiner states that even if “extended time” in Adler refers to less than 5 minutes, it would have been obvious to modify the apparatus to store a product for 5 minutes or longer. Also, the Examiner states that if it is shown Adler does not allow for changing the amounts of water and other ingredients to get a desired combination, it would have been obvious to do so. In addition, in regards to Claims 5, 6 and 9-15, the Examiner generally states that it would have been obvious to optimize such characteristics as dilution time, brew solids and amount of water to produce the desired beverage. Applicants respectfully traverse these rejections.

The Examiner bears the burden of factually supporting any prima facie conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fe. Cir. 1983). Distilling the invention down to the “gist” or “thrust” of an invention disregards the requirement of analyzing the subject matter “as a whole.” See W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983). Inventors of unobvious compositions, such as those of the present invention, enjoy a *presumption* of non-obviousness, which must then be overcome by the Examiner establishing a case of prima facie obviousness by the appropriate standard. If the Examiner does not prove a prima facie case of unpatentability,

then without more, the Applicant is entitled to grant of the patent. See In re Oetiker, 977 F.2d 1443.

To establish a prima facie case of obviousness under 35 U.S.C. §103, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the reference itself, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the cited reference must teach or suggest *all* the claim limitations. See, for example, In re Vaack, 947 F.2d 488 (Fed. Cir. 1991). Applicants respectfully assert that the Office Action fails to establish this third criteria, and thus, fails to make a prima facie case of obviousness under 35 U.S.C. § 103.

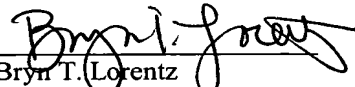
As Applicants have presently cancelled all of the claims rejected herein under 35 U.S.C. §103, Applicants respectfully request the Examiner withdraw the rejection on this basis alone. However, similar to the rejection under §102, in a sincere effort to advance the prosecution of this case, Applicants wish to address the Examiner's rejections as they apply to the presently added Claims 55-79.

In this regard, Applicants respectfully assert that Adler fails to teach all the limitations of presently added Claims 55-79. Specifically, Adler does not teach storing a coffee extract in contact with coffee grounds. Indeed, as discussed previously in the §102 remarks, Adler is not even concerned with brewing coffee extracts, but rather, focuses solely on dispensing coffee beverages. Moreover, there is no teaching in Adler of the notion of delayed filtering of an extract. Applicants respectfully assert that there is no teaching of filtering at all in Adler. Again, as the Adler machine only dispenses, rather than brews, coffee, Adler fails to teach the presently claimed notion of delaying filtration of an extract. Therefore, for these reasons, Applicants respectfully assert that the present claims would not be obvious in view of Adler. Thus, Applicants respectfully request the Examiner withdraw the rejection under §103.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the Examiner's rejections under 35 U.S.C. §§ 101, 112, 102 and 103 have all been overcome. Withdrawal of these rejections is respectfully requested.

Respectfully submitted,

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